

## **REMARKS**

The Applicants thank the Examiner for the Office Action of April 1, 2008.

### **1) Status of Case**

The case originally included claims 1 – 70. Those claims were cancelled in favour of a revised set of claims 71 – 194 in view of the Rule changes that were to have become effective on November 1, 2007.

The Office Action provides a requirement for Restriction between 11 groups of claims, identified as groups A to K. As suggested in the Supplementary Amendment of October 28, 2007, Group A, being claims 71 – 94, has been examined, and Groups B – K have been withdrawn from consideration at present. In the Office Action of April 1, 2008, all of claims 71 – 94 were rejected under 35 USC 102(b) as being anticipated by US Patent 4,483,253 of List. Claims 72 – 75 were also rejected under 35 USC 112.

### **2) Rejection Under 35 USC 112 – Claims 72 - 75**

This rejection appears to arise out of the admittedly somewhat complicated grammatical structure of claim 71. That structure, in turn, arises out of the geometric relationship that the claim is attempting to address.

The physical relationship addressed by claim 71 is that of a rolling contact rocker that provides self-steering. In that physical relationship it is sufficient that either one of (a) the bearing adapter; and (b) the pedestal seat, have a fore-and-aft arcuate profile that can rock in rolling contact on another part. Also, as noted in the disclosure (WO 2005 / 005219, page 28, line 35 to page 29, line 23) it is arbitrary which part is the male part and which is the female part. The geometry can be reversed. Therefore, since it is the same invention either way, the claim language must address both situations – i.e., when the curved rocker is the upper surface of the bearing adapter, and when the curved surface is the lower surface of the pedestal seat.

Consequently, claim 71 has the grammatical structure: One of (a) [a bearing adapter incorporating the claimed rolling contact surface, for use with something else] ; and (b) [a pedestal seat incorporating the claimed rolling contact surface, for use with something else]. The Applicants acknowledge that the resultant sentence structure is not necessarily overly graceful.

However, it is stolid and grammatically structurally sound.

Keeping in mind that, formally, claim 71 claims “At least one self-steering apparatus fitting ...”, the preamble of claims 72 and 74 were, correctly, “The self-steering apparatus of claim 71 wherein ...”

Claim 72 specifies that the claimed item falls under the first branch of claim 71. Grammatically, that fitting is “(a) a bearing adapter”. The bearing adapter is “for use with” at least one other fitting. The Office Action refers to the “at least one other fitting” as if it were part of the claimed invention. it is not. There appears to be some confusion in the Office Action in this regard. Claim 71 does not claim the “at least one other fitting”, and so neither does claim 72. As noted, similar confusion has arisen with respect to claim 74. Again, in claim 74 the “at least one other fitting” is not part of the claimed invention. The Applicants believe that a careful reading of claims 72 and 74 will reveal that while they may have a complicated structure in a grammatical sense, nonetheless that structure was correct.

The Applicants believe that claims 72 and 74, and their relationship with claim 71, was correctly structured as previously submitted. However, in an effort to eliminate possible confusion, the Applicant has amended both the preamble and the body of claims 72 and 74. If these amendments are not acceptable to the Examiner, the Applicants reserve the right to return the claims to their former condition, which the Applicants still believe was grammatically sound.

In any case, the Applicants request reconsideration and withdrawal of the rejections of claims 72 and 74 under 35 USC 112, and allowance of those claims and any claims dependent from them, namely claims 73 and 75.

**3) Rejection Under 35 USC 102(b) – US Patent 4,483,253 of List**

**(a) Test for Anticipation Under 35 USC 102(b) – MPEP 2131**

**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the

structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02 < "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 USC 102 rejection. See MPEP s. 2131.01.

**(b) Claim 71**

Claim 71 reads as follows:

71. At least one self-steering apparatus fitting for use in a railroad car truck between a wheelset bearing and a sideframe pedestal, said self-steering apparatus fitting comprising at least one of:

- (a) a bearing adapter for mounting to a casing of a bearing on a wheelset, said bearing adapter being for use in combination with at least one other fitting of the self-steering apparatus, said at least one other fitting including at least a pedestal seat; said bearing adapter having a rolling contact engagement surface for orientation facing away from the wheelset when installed; and said bearing adapter rolling contact engagement surface has a fore-and-aft arcuate profile permitting rolling contact rocking of the wheelset bearing lengthwise relative to the sideframe; and
- (b) a pedestal seat mountable in a pedestal of a sideframe of the railroad car truck, said pedestal seat being for use in combination with at least one other fitting of the self-steering apparatus, said at least one other fitting including at least a bearing adapter; said pedestal seat having a rolling contact engagement surface for orientation toward the wheelset; and the pedestal seat rolling contact engagement surface has a fore-and-aft arcuate profile permitting rolling contact rocking of the wheelset bearing lengthwise relative to the sideframe.

**(c) Features Missing From List Reference**

The claim is directed toward a self-steering apparatus fitting, be it a bearing adapter as in part (a) or a pedestal seat as in part (b) that has a "rolling contact engagement surface" that "has a fore-and-aft arcuate profile permitting rolling contact rocking of the wheelset bearing lengthwise relative to the sideframe".

The List reference does not have the recited “rolling contact engagement surface”.

On the contrary, List relies upon the “introduction of flexibility between the roller bearing adapters and the side frames. This flexibility is achieved by the introduction of yieldable motion restraining means, preferably elastomeric in nature, between said bearing adapters and the side frames.” (List, col. 2, lines 2 – 7). List tells us “The mentioned flexibility between the roller bearing adapters and the side frames allows the axles to yaw relative to each other.” (List, col. 2, lines 18 – 20). To this end, List employs elastomeric pads **14**, identified in Figures **4** and **5**. List says that “the shear stiffness of the elastomeric pads **14**, added between the adapters **6** and the sideframes, at pedestal locations **B**, is effective in restraining inter-axle lateral and yaw motions ...” (See List, col. 5, lines 19 – 22 et seq.) That is, List relies on deflection of an elastomeric shear pad for the purpose of obtaining relative yaw deflection of the axles, i.e., self-steering. List does not rely upon (and does not show, describe, or suggest) rolling contact of a rolling contact rocking surface having a fore-and-aft arcuate profile.

As such, the List reference does not show, describe or suggest all of the features of the claim as required by the test for anticipation in *Verdegaal Bros. v. Union Oil Co. of California*, and *Richardson v. Suzuki Motor Co.* (both cited above). The Applicants therefore respectfully request that the current rejection of claim 71 under 35 USC 102 (b) be reconsidered and withdrawn, and the claim allowed.

**(d) Dependent Claims 72 - 89**

All of claims 72 – 89 depend from claim 71. Insofar as claim 71 is not anticipated by the List reference, so also claims 72 – 89 are not anticipated. On that ground, the Applicants request reconsideration and withdrawal of the rejections, and allowance of those dependent claims.

Further, however, the Applicants note that List neither shows a bearing adapter having the fore-and-aft arcuate profile of claim 72, nor a pedestal seat having such geometry as in claim 74, nor a fitting having either a spherical surface or a body of revolution having an axis parallel to the axis of the bearing or cross-wise to the longitudinal axis of the sideframe as in claims 73 and 75 respectively, nor the combination of fore-and-aft and cross-wise arcuate profiles of claim 76. As a matter of clarity, both claims 72 and 74 have been amended to add the words “of claim 71”. Similar amendments have been made in claims 86, 87 and 88. These amendments do not alter the scope of the claims in any way and are not intended to alter the breadth of interpretation to which these claims are entitled under the Doctrine of Equivalents.

Further still, List does not show the combination of bearing adapter and pedestal seat having the mating rolling contact relationship of claim 77. (Note that in List, even if the bearing adapter and the pedestal seat had the recited geometry, which they do not, they cannot engage in rolling contact because the shear pad physically separates the parts in any event.) Claim 78 recites a “third fitting” that is operable to urge the first and second fittings to a centered relationship relative to each other. The Office Action does not identify a third fitting. Claim 79 recites the combination of both the (a) and (b) parts of claim 71. List does not have parts satisfying either (a) or (b).

Claim 80 recites fittings able also to rock laterally in rolling contact. Claim 81 recites that one of the parts has a compound curvature. List apparently has no such features. (Note: claim 81 has been amended to add a comma after “pedestal seat”). Claim 82 recites a spherical surface. List appears not to have any such spherical surface. Claim 83 again recites the “third fitting” that is not identified by the Office Action. Claim 84 indicates that the third fitting is formed to seat about the thrust lug. Claim 85 cites additional geometric requirements. Since List doesn’t have the “third fitting”, the geometry of claims 84 and 85 is also absent. Likewise, the geometric requirements of claim 86 are not shown, described or suggested by List. Claims 87 and 88 recite a relief in the bearing adapter above the bearing races. This feature is not shown, described or suggested in List. Claim 89 recites the combination of a bearing adapter, a pedestal seat, and an auxiliary centering pad that accommodates mating engagement of the rocker members of the pedestal seat and the bearing adapter. The Applicants have not been able to identify any of these features in the List reference.

Therefore, for these additional reasons, the Applicants respectfully request the reconsideration and withdrawal of the rejections of each of these individual dependent claims 72 – 89, and the allowance of those claims.

(e) **Claim 90**

The Applicants make the same arguments with respect to claim 90 as previously made in respect of claim 71. In addition, claim 90 recites that the rolling contact surface has a curvature that is either spherical or is formed on a body of revolution having an axis the is either parallel to the axis of the bearing adapter arches (in the case of the bearing adapter) or cross-wise with respect to the sideframe (in the case of the pedestal seat). The List reference does not show, describe or suggest these features. As such, the Applicants respectfully request that the rejection of claim 90 be

reconsidered and withdrawn, and that the claim be allowed.

**(f) Dependent Claims 91 - 94**

All of claims 91 – 94 depend from claim 90. To the extent that claim 90 is not anticipated by the List reference, so also claims 91 – 94 are not anticipated by List. On that ground, alone, the Applicants request reconsideration and withdrawal of the rejections, and allowance of those claims. In addition, however, the Applicants also note that the Office Action does not identify in the List reference the resilient centering member of claim 93, or the bearing adapter relief of claim 94, and, on these additional grounds the Applicants request reconsideration of the rejections of those claims as well.

**4) Conclusion**

The Applicant respectfully submits that claims 71 – 94 currently pending in this case are currently in condition for allowance, and seeks early and favourable disposition of this matter.

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